

### **REMARKS**

Claims 1-10 are currently pending in the application. Claims 1-6 and 10 have been withdrawn from consideration. The Examiner states claims 7-9 are currently examined. Claims 1-6 and 10 have now been canceled. Applicants expressly reserve the right to file divisional applications or take such other appropriate measures deemed necessary to protect the inventions in the canceled claims. Claims 7-9 has been amended in the present response. No new matter has been added by way of amendment. Applicants respectfully request reconsideration of the claims in view of the following remarks.

#### **I. Detailed Action**

##### ***A. Status of Application***

Applicants acknowledge claims 1-6 and 10 are withdrawn from consideration as being directed to the invention non-elected in parent U.S. Serial No. 09/770,564.

Applicants have now canceled claims 1-6 and 10 in the present response.

##### ***B. Oath / Declaration***

Applicants respectfully traverse the rejection to the oath/declaration as being defective by the Examiner. Applicants assert the declaration of record, submitted with the present application on July 22, 2003, does state the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 C.F.R. §1.56 (see page 1, sixth paragraph of declaration previously submitted). Further Applicants submit that in a divisional or continuing application it is not a requirement to list the present US application 09/352,168 according to MPEP §602.05(a). As stated in MPEP §602.05(a), "[a] copy of an oath or declaration from a prior application may be submitted with a continuation or divisional application even if the oath or declaration identifies the application number of the prior application". Applicants respectfully request reconsideration of the objection.

##### ***C. Claim Objections***

Claim 9 stands objected to for "a fungus producing fumonisins".

Applicants have amended claim 9 to delete the language "a fungus producing fumonisin" and replace it with --fumonisin producing fungus--, as suggested by the Examiner thereby making this objection moot.

## **II. Claim Rejections - 35 U.S.C. §112, Second Paragraph**

Claim 9 stands rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner further notes that the claim is indefinite because "the fumonisin esterase and APAO enzyme" lacks antecedent basis.

Applicants have now amended claim 9 to include proper antecedent basis, thus alleviating this rejection.

In light of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §112, second paragraph.

## **III. Claim Rejections – 35 U.S.C. §112, First Paragraph**

### *Written Description*

Claims 7-9 stand rejected under 35 U.S.C. §112, first paragraph, for containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Examiner states that the claims are drawn to a transformed plant comprising a polynucleotide having at least 95% sequence identity to SEQ ID NO: 5 or 10, and a method for reducing fumonisin by expressing said polynucleotide in a plant.

Applicants have amended claims 7-9 by inserting --, wherein the polynucleotide encodes a polypeptide having fumonisin degrading activity--, as suggested by the Examiner, thereby alleviating this rejection. Applicants therefore respectfully request that the rejection of the claims under 35 U.S.C. §112, first paragraph for written description, be withdrawn.

## **IV. Double Patenting**

Claims 7-9 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,211,435. The

Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other because the invention claimed in both the application and the issued patent encompasses SEQ ID NO: 5 or 10, and a method for reducing fumonisin in a transgenic plant. The Examiner states the instantly claimed invention encompasses the invention claimed in the issued patent.

Applicants are herein submitting a Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c), which disclaims any term of a patent issuing from this application which would extend beyond the term of U.S. Patent No. 6,211,435. Therefore, Applicants submit that the claims are in proper form for allowance and respectfully request reconsideration and withdrawal of the obviousness-type double patenting rejection.

#### V. Conclusion

In light of the above amendments and remarks, Applicants respectfully assert that claims 7-9 are now in condition for allowance. Applicants respectfully request reconsideration and withdrawal of the above rejections. If it is felt that it would aid in prosecution, the Examiner is invited to contact the undersigned at the number indicated to discuss any outstanding issues.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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